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RALPH E. JOCKE			KHATTAK, RAJESH	
Walker & Jocke				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/621,433	Applicant(s) HANNA ET AL.
	Examiner RAJESH KHATTAR	Art Unit 3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on **8/16/2010**.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) **1-75** is/are pending in the application.
- 4a) Of the above claim(s) **1-41** is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) **42-75** is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Acknowledgements

This office action is in response to Applicant's communication filed on 8/16/2010.

Claims 1-41 have been cancelled. New claims 42-75 have been added. As such, claims 42-75 are pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 42-48, 50, 52-59, 61, 63-72 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukatsu, US Patent No. 4,743,743.

Regarding claim 42, Fukatsu discloses a method comprising:

(a) operating a deposit-accepting automated banking machine during a deposit transaction involving a customer to receive into an interior area of the machine, at least one check manually inserted through an access opening of the machine (col. 1, lines 10-col. 2, lines 49, col. 3, lines 1-col. 4, lines 64, col. 5, lines 14-20, col. 5, lines 35-50, claims 1-3, Fig. 2),

wherein the machine includes at least one computer (Fig. 2, machine 11 coupled to computer 13, main controller 36),

wherein the machine is operative to communicate with a financial transaction host computer (Fig. 2, computer 13 serves as a financial transaction host computer, col. 2, lines 1-23, col. 5, lines 9-36),

wherein the machine includes at least one radio frequency identification (RFID) tag reader (Fig. 2, check reader 38 serves as a tag reader, col. 5, lines 9-36),

wherein each respective check includes at least one RFID tag (Fig. 9, the check number, transferer and transferee account numbers represent tag, col. 4, lines 55-65),

wherein the at least one RFID tag of each respective check includes at least one of deposit data corresponding to an identifier of a customer banking account to which the deposit is to be credited (Fig. 9, account number, col. 4, lines 55-65), and

deposit data corresponding to a financial amount being deposited (Fig. 6, 7, face value of the check, col. 5, lines 34-36);

(b) operating the machine during the deposit transaction to cause the at least one RFID tag reader to wirelessly read from each check, the at least one RFID tag (Fig. 2, col. 5, lines 9-36, check reader/OCR automatically read the face value serves as tag reader to wirelessly read each check);

(c) operating the machine during the deposit transaction to output at least one customer receipt which corresponds to the deposit transaction (Fig. 4, print receipt, col. 4, lines 40-47, transaction slip, Fig. 7); and

(d) operating the machine to send to the financial transaction host computer, transaction data associated with the deposit transaction (col. 4, lines 27-67, data sent to computer 13 which serves as a financial transaction host computer).

Examiner notes that Fukatsu discloses the use of a check reader and not specifically disclose the use of radio frequency identification (RFID) tag reader. The use of a radio frequency identification device (which is well known in the art as per Applicant's disclosure, see specification page 69, lines 14-22) is clearly an aesthetic design change (see MPEP § 2144.04). The design change that relates to ornamentation only and have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the above-noted disclosure of Fukatsu as it relates to depositing a check into an ATM by using a check reader/OCR unit to include a RFID device. The motivation for incorporating an RFID device would have been to use an alternative reader with different capabilities than the conventional card reader/OCR unit.

Regarding claim 43, Fukatsu discloses wherein (b) includes reading both deposit data corresponding to the identifier and deposit data corresponding to the financial amount (Fig. 9, col. 4, lines 55-65, Fig. 6,7, col. 5, lines 34-36, account number serves as identifier).

Regarding claim 44, Fukatsu discloses wherein (c) includes outputting at least one receipt comprising an RFID tag (Fig. 7, col. 4, lines 40-47).

Regarding claim 45, Fukatsu discloses wherein (c) includes printing the at least one receipt (Fig. 7, col. 4, lines 40-47).

Regarding claim 46, Fukatsu discloses wherein in (b) the at least one RFID reader is located inside the machine (Fig. 2, check reader 38).

Regarding claim 47, Fukatsu discloses wherein the deposit accepting machine comprises an automated merchant banking apparatus, wherein (a) includes receiving the at least one check into the automated merchant banking apparatus (col. 1, lines 10-col. 2, lines 49, col. 3, lines 1-col. 4, lines 64, col. 5, lines 14-20, col. 5, lines 35-50, claims 1-3, Fig. 2, ATM).

Regarding claim 48, Fukatsu discloses wherein the deposit accepting machine comprises an ATM, wherein (a) includes receiving the at least one check into the ATM (col. 1, lines 10-col. 2, lines 49, col. 3, lines 1-col. 4, lines 64, col. 5, lines 14-20, col. 5, lines 35-50, claims 1-3, Fig. 2).

Regarding claim 50, Fukatsu discloses wherein (a) further includes receiving cash into the ATM (col. 1, lines 10-col. 2, lines 49, col. 3, lines 1-col. 4, lines 64, col. 5, lines 14-20, col. 5, lines 35-50, claims 1-3, Fig. 2).

Regarding claim 52, Fukatsu discloses wherein the machine includes a depository, wherein (a) includes receiving the at least one check into the depository (col. 2, lines 10-12, storage box 21, Fig. 1).

Regarding claim 53, Fukatsu discloses

(a) operating a deposit-accepting automated banking machine during a deposit transaction involving a customer to receive into an interior area of the machine (col. 1, lines 10-col. 2, lines 49, col. 3, lines 1-col. 4, lines 64, col. 5, lines 14-20, col. 5, lines 35-50, claims 1-3, Fig. 2),

a deposit ticket manually inserted through an access opening of the machine (col. 5, lines 35-50, a customer fills in a form on an envelope represents a deposit ticket), and

at least one of

at least one check (col. 5, lines 35-50, check is inserted in the envelope), and cash,

wherein the machine includes at least one computer (Fig. 2, machine 11 coupled to computer 13, main controller 36),

wherein the machine is operative to communicate with a financial transaction host computer (Fig. 2, computer 13 serves as a financial transaction host computer, col. 2, lines 1-23, col. 5, lines 9-36),

wherein the machine includes at least one radio frequency identification (RFID) tag reader (Fig. 2, check reader 38 serves as a tag reader, col. 5, lines 9-36),

wherein the deposit ticket includes at least one RFID tag (col. 5, lines 35-50, customer fills in a form on an envelope serves as tag),

wherein the at least one RFID tag includes at least one of deposit data corresponding to an identifier of a customer banking account to which the deposit is to be credited (col. 5, lines 35-50, consumer fills in a form on an envelope. since, the consumer depositing a check, the data on the form of the envelope obviously contains deposit data, the inserted check contains deposit data, col. 3, lines 60-col. 4, lines 7, Fig. 6-9), and

deposit data corresponding to a financial amount being deposited (col. 5, lines 35-50, consumer fills in a form on an envelope, since the consumer is depositing a check, the data on the form of the envelope obviously contains deposit data which may include financial amount to be deposited, the inserted check obviously contains deposit data corresponding to a financial amount being deposited, Fig. 6, 7, face value of the check, col. 5, lines 34-36);

(b) operating the machine during the deposit transaction to cause the at least one RFID tag reader to wirelessly read from the deposit ticket, the at least one RFID tag (Fig. 2, col. 5, lines 9-36, check reader/OCR automatically read the face value serves as tag reader to wirelessly read each check);

(c) operating the machine during the deposit transaction to output at least one customer receipt which corresponds to the deposit transaction (Fig. 4, print receipt, col. 4, lines 40-47, transaction slip, Fig. 7); and

(d) operating the machine to send to the financial transaction host computer, transaction data associated with the deposit transaction (col. 4, lines 27-67, data sent to computer 13 which serves as a financial transaction host computer).

Examiner notes that Fukatsu discloses the use of a check reader and not specifically disclose the use of radio frequency identification (RFID) tag reader. The use of a radio frequency identification device (which is well known in the art as per Applicant's disclosure, see specification page 69, lines 14-22) is clearly an aesthetic design change (see MPEP § 2144.04). The design change that relates to

Art Unit: 3693

ornamentation only and have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the above-noted disclosure of Fukatsu as it relates to depositing a check into an ATM by using a check reader/OCR unit to include a RFID device. The motivation for incorporating an RFID device would have been to use an alternative reader with different capabilities than the conventional card reader/OCR unit.

Claims 54 and 65-67 are substantially similar to claim 43 and hence rejected on similar grounds. In claims 66 and 67, the deposit bag ID is interpreted by the Examiner as the name of the account holder (depositor's name). In claim 67, the depositor ID is interpreted by the Examiner as account number.

Claims 55 and 68 are substantially similar to claim 44 and hence rejected on similar grounds.

Claims 56 and 69 are substantially similar to claim 45 and hence rejected on similar grounds.

Claims 57 and 70 are substantially similar to claim 46 and hence rejected on similar grounds.

Claims 58 and 71 are substantially similar to claim 47 and hence rejected on similar grounds.

Claims 59 and 72 are substantially similar to claim 48 and hence rejected on similar grounds.

Claims 61 and 74 are substantially similar to claim 50 and hence rejected on similar grounds

Claim 63 is substantially similar to claim 52 and hence rejected on similar grounds.

Claim 64 is substantially similar to claim 53 and hence rejected on similar grounds. Examiner interprets deposit bag in claim 64 to be an envelope containing a check and is disclosed by Fukatsu in col. 5, lines 35-50.

Claims 49, 51, 60, 62, 73 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukatsu, US Patent No. 4,743,743 in view of Fukatsu, US Patent No. 4,593,183 (hereinafter Fukatsu'183). Fukatsu describes the invention as disclosed above. Fukatsu fails to specifically disclose the limitations of claim 49 and 51.

Regarding claim 49, Fukatsu'183 discloses wherein the ATM includes a cash dispenser, and further comprising (e) operating the ATM to cause the cash dispenser to dispense cash from the ATM (col. 13, lines 23-31, col. 1, lines 12-20).

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the above-noted disclosure of Fukatsu as it relates to depositing a check into an ATM by using a check reader/OCR unit to include an RFID device and the above-noted disclosure of Fukatsu'183 as it relates to dispensing cash from the ATM. The motivation for combining these two references would have been to use ATM for withdrawing money from an account.

Regarding claim 51, Fukatsu'183 discloses wherein the ATM includes a cash dispenser, and further comprising (e) operating the ATM to cause the cash dispenser to dispense from the ATM, cash received in (a) (col. 13, lines 23-31, col. 14, lines 12-20).

Claims 60 and 73 are substantially similar to claim 49 and hence rejected on similar grounds.

Claims 62 and 75 are substantially similar to claim 51 and hence rejected on similar grounds.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 42-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 11/789,657. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed towards depositing a financial instrument into an ATM.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3693

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAJESH KHATTAR whose telephone number is (571)272-7981. The examiner can normally be reached on Flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rajesh Khattar/
Examiner, Art Unit 3693